

REMARKS

Upon entry of the instant amendment, claims 7-18 will remain pending in the above identified application with claims 7-12 standing ready for further action on the merits and claims 13-18 being withdrawn from consideration based on an earlier restriction requirement of the Examiner.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. For example, claim 8 has simply been redrafted as an independent claim by incorporating there into limitations previously recited in claim 1, and the dependencies of claims 13, 15 and 17 have been changed to claim 8, based on the cancellation of claim 1. Also, claims 17-18 have also been amended to replace the initial "An" with "A", so as to be more grammatically correct.

Accordingly, entry of the instant amendment is respectfully requested at present.

Verified English Translations of Priority Documents

Enclosed herewith are verified English Translations of JP 2002-377390 and JP 2002-377321, upon which the Applicants claim priority under 35 USC § 119. JP 2002-377390 and JP 2002-377321 were each filed in the Japan Patent Office on December 26, 2002.

Examiner Initiated Interview/Restriction Requirement

As indicated in the Office Action, the Examiner has required restriction in the matter of the instant application requiring election between the following three allegedly distinct inventions:

- I. Claims 1-12 drawn to a polishing composition, classified in class 51, subclass 308.
- II. Claims 13-16 drawn to method of polishing, classified in class 216, subclass 89.
- III. Claims 17-18 drawn to a substrate, classified in class 510, subclass 175.

Applicants affirm their prior telephonic provisional election of claims 1-12 on September 20, 2005, having been made with traverse. While claims 13-18 are now deemed drawn to a withdrawn/non-elected invention, rejoinder of claims 13-18 is respectfully requested upon allowance of claims 1-8.

The Examiner's statements in the Interview Summary and the Restriction requirement of September 20, 2005 are correct with regard to the subject matter under discussion at that time.

Claim Rejection – 35 USC § 112, Second Paragraph

Claims 8 and 10 have been rejected under the provisions of 35 USC § 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention that the Applicants regard as their invention. Reconsideration and withdraw of this rejection is respectfully requested based on the amendment made herein to claim 8, wherein claim 8 is now an independent claim that does not depend from claim 7.

It is also noted that the remaining claims that depend from independent claim 8, i.e., claims 10, 13, 15 and 17 all fully comply with the provisions of 35 USC § 112, Second Paragraph.

Claim Rejections – 35 USC § 103(a)

The Examiner has set forth four (4) separate rejections of claims 1-12 under the provisions of 35 USC § 103(a) over each of the following individual references: **Koichi et al. '175** (US 6,551,175), **Oshima '789** (US 2002/0194789), **Ota et al. '711** (US 2003/0110711), and **Takashina et al '217** (US 2004/0040217). Reconsideration and withdraw of each of these separate rejections is respectfully requested based on the following considerations.

Legal Standard for Determining Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Distinctions Over the Cited Art

Oshima '789

The cited Oshima '789 reference has a publication date of December 26, 2002, and is assigned to Kao Corporation, which is also the assignee of the present invention. Notably, since the invention recited in the instant claims and the cited Oshima '789 reference had the same assignee (Kao Corporation) at the time of the latter invention, it follows that the Oshima '789 reference is not citable against the instant claims as of its US filing date (April 24, 2002), due to the safe harbor provisions of 35 USC § 103(c). It is only citable as of its December 26, 2002 publication date.

The December 26, 2002 publication date of the Oshima '789 reference, is the same date as Applicant's priority date under 35 USC §119 to each of JP 2002-377390 and/or JP 2002-377321.

Accordingly based on the submission of the enclosed verified English translations of JP 2002-377390 and JP 2002-377321 (which provide full 35 USC 112, first paragraph support for the invention

now being claimed), it is submitted that the cited Oshima '789 reference has been effectively antedated for all that it teaches and discloses.

Takashina et al '217

The cited Takashina et al. '217 reference has a publication date of March 4, 2004, and is assigned to Kao Corporation, which is also the assignee of the present invention. Notably, since the invention recited in the instant claims and the cited Takashina et al. '217 reference had the same assignee (Kao Corporation) at the time of the latter invention, it follows that the Takashina et al. '217 reference is not citable against the instant claims as of its US filing date (August 11, 2003), due to the safe harbor provisions of 35 USC § 103(c). Instead, it is only citable as of its March 4, 2004 publication date.

The March 4, 2004 publication date of the Oshima '789 reference, is clearly after the December 4, 2003 filing date of the instant application in the USPTO, so that the rejection over the cited Takashina et al. '217 must be withdrawn.

Koichi et al. '175

The cited Koichi '175 reference defines the particle size distribution of the abrasive therein merely by a ratio of D50 to D90, so that the specific particle size distribution defined in the present invention is in no way disclosed or suggested therein.

Further, in the cited Koichi '175 reference, it is described that an especially favorable D10 value is 40-60 nm in Embodiment 1 (see column 4, lines 18-25) and that a favorable percentage of particles having a particle size of 40 nm or less is 3% or less in Embodiment 2 (see column 5, lines 27-33). Supporting these descriptions, in Examples I-1 to I-5 of the cited reference, an abrasive is used, having a

particle size distribution wherein D10 is 45 nm or more (e.g., see Table 2, starting at column 10, line 57).

It can be reasonably supposed that the polishing compositions in the examples of the cited Koichi '175 reference would not satisfy the requirement of the present invention. (In the cited reference, the particle size distribution is defined on a number basis so that it cannot be directly compared with the particle size distribution in the present invention defined on a weight or volume basis.)

As noted above, in the cited Koichi '175 reference, it is favorable that the ratio of particles having a particle size of 40 nm or less is low. The feature of the cited reference is opposite to the feature of the present invention which requires a specific amount or more of polishing particles having a particle size of 5-40 nm. Accordingly, the present invention not obvious over the cited Koichi '175 reference.

Ota et al. '711

The polishing compositions satisfying the particle size distribution defined in the Ota '711 reference are disclosed in the specification of the instant application as Comparative Examples II-5 to II-9. These comparative examples in the instant application correspond to the examples of the cited Ota '711 reference as indicated in the below table.

Examples of Ota et al. (US 2003/0110711)	α or β	γ	δ	ϵ , η , or θ	ξ
Comp. Example of the present invention	II-5	II-6	II-7	II-8	II-9

As shown in Table 4 of the instant application (see page 43), Examples II-1 to II-4 satisfying the requirement of the present invention show remarkable effects in reducing micropits in comparison with Comparative Examples II-5 to II-9. That is, the present invention exhibits excellent effects which cannot be expected by the cited Ota '711 reference.

In addition, since the cited reference discloses combinations of monomodal abrasives, there is an open portion in the particle size distribution of the cited reference. Further, in the cited Ota '711 reference, the particle size distribution is defined on a number basis so that it cannot be directly compared with the particle size distribution in the present invention, which is defined on a weight or volume basis.

It is not obvious to find the specific particle size distribution necessary for exhibiting unexpected effects based on such an uncomparable particle size distribution as noted above. Accordingly, the particle size distribution of the present invention is not rendered obvious by the cited Ota '711 reference.

Based on the above considerations, it is submitted that no motivation or teaching is found in the cited art of Koichi et al. '175 or Ota et al. '711 that would allow one of ordinary skill in the art arrive at the instant invention as claimed. Absent such motivation in the cited art the outstanding rejections cannot be sustained.

Provisional Obviousness-Type Double Patenting Rejections

Claims 1-2 and 7-10 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-6 of copending Application No. 10/637,568. Claims 1-6 have also been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-6 of copending Application No. 10/727,571. Reconsideration and

withdrawn of these two provisional obviousness-type double patenting rejections is respectfully requested based on the following facts:

- (i) The filing herewith of an appropriate terminal disclaimer for overcoming the provisional obviousness-type double patenting rejection over copending Application No. 10/637,568, and
- (ii) The cancellation herein of claims 1-6 in the instant application.

CONCLUSION

Based on the amendments and remarks made herein, the filing herewith of verified English translations of Applicants priority documents (JP 2002-377390 and JP 2002-377321), and the submission herewith of an appropriate terminal disclaimer over copending Application No. 10/637,568, the Examiner is respectfully requested to issue a notice of allowance indicating that instant claims 7-12 are allowed and patentable under title 35 of the United States Code. The Examiner is further requested to rejoin withdrawn method claims 13-16 (and withdrawn substrate claims 17-18), and also indicate their allowability in the notice of allowance.

Should the Examiner have any questions concerning the present reply, he is respectfully requested to contact the undersigned at the telephone number provided, in order to expedite matters relating to the prosecution of this application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: OCT 21 2005

Respectfully submitted,

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Enclosures:

Verified English Translations of JP 2002-377390 and JP 2002-377321
Terminal Disclaimer Over Copending Application No. 10/637,568